UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,192	11/16/2001	John Saare	SUN-P6492NP US/NC	6370

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EXAMINER
PHILLIPS, HASSAN A

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/015,192	SAARE ET AL.
Office Action Summary	**Examiner**	**Art Unit**	
	Hassan Phillips	2151	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *17 June 2004*.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-17* is/are pending in the application.
    4a) Of the above claim(s) *7-11* is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-6 and 12-17* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) *1-6 and 12-17* are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *21 January 2004* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
      a) ☐ All b) ☐ Some * c) ☐ None of:
         1. ☐ Certified copies of the priority documents have been received.
         2. ☐ Certified copies of the priority documents have been received in Application No. _____.
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
              application from the International Bureau (PCT Rule 17.2(a)).
      * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *9/25/03*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

    A) Claims 1-6, and 12-17, drawn to a method and system for client/server interaction classified in class 709, subclass 203.

    B) Claims 7-11, drawn to presentation processing of a document classified in class 715, subclass 513.

The inventions are distinct from each other for the following reasons:

Inventions A and B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention A has separate utility for transferring data across a network between a client and a server, which is separately usable with or without invention B, which has utility for generating a Java server page. See § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In a phone message left by Robert Lord (Reg. No. 46,479) on February 3, 2004, a provisional election was made without traverse to prosecute invention A. Applicant in replying to this office action must make affirmation of this election. Claims 7-11 are

withdrawn from further consideration by the Examiner, (See 37 CFR1.142 (b)), as being

drawn to a non-elected invention.

Information Disclosure Statement

2. The information disclosure statement filed on September 25, 2003, has been

received and considered by the Examiner.

Drawings

3. The drawings filed on January 21, 2004, have been received and considered

by the Examiner.

Specification

4. The disclosure is objected to because of the following informalities: The

reference numeral 263 should be placed behind "Java server page rules" on page 17,

line 18. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, 12-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Murren et al. (hereinafter Murren), U.S. Patent Pub. No. 2003/0078960, in view of the Applicants Admitted Prior Art (AAPA).

7. In considering claims 1 and 12, Murren teaches a method and system for providing extensible client functions using a distributed computer network comprising:

a) receiving a request for functions from a client, (page 1, paragraphs 7-8);

b) accessing a Java server page corresponding to the request, (page 16, paragraph 148);

c) accessing a plurality of tags contained within the Java server page, (page 16, paragraph 149);

d) processing the Java server page using the tags to access a server for providing the functions, (page 16, paragraph 149, Fig. 2, and Fig. 10); and

e) transmitting the processed Java server page, including information responsive to the request, to the client, (page 16, paragraph 149, Fig. 2, and Fig. 10).

Although the disclosed method and system taught by Murren shows substantial features of the claimed invention, it fails to expressly disclose: the functions being address book functions.

Nevertheless, on page 3, lines 9-15, of the Applicants disclosure, the Applicant admits that Web portals providing e-address books, have become increasingly popular.

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Murren with the AAPA to show the functions being address book functions.

This would have provided an efficient means for users of different domains and different types of client devices to access extensible client address book functions using a distributed computer network, Murren col. 1, paragraphs 6-9.

8. In considering claims 2 and 13, Murren further teaches accessing the Java server page corresponding to the request, wherein the Java server page is retrieved from a set of compiled Java server page classes. See page 22, paragraph 204.

9. In considering claims 3 and 14, the combined teachings of Murren and the AAPA provide a means for the tags contained within the Java server page to be configured to provide access to address book functions provided by an address book server. See Murren pages 8-10, paragraphs 100-109.

10. In considering claims 4 and 15, the combined teachings of Murren and the AAPA provide a means for providing extended address book functions by accessing a plurality of extended tags contained within the Java server page, wherein address book functions are extended by adding the extended tags corresponding to new address book functionality of an address book server. See Murren pages 19-21, paragraphs 183-202.

11. In considering claims 5 and 16, Murren teaches transmitting the processed

Java server page to the client in accordance with WAP (wireless application protocol)

communication standards. See page 2, paragraph 39.

12. In considering claims 6 and 17, Murren teaches transmitting the processed

Java server page to the client in accordance with WML (wireless markup language)

communication standards. See page 4, paragraph 62.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
   Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

14. Claims 1-6, 12-17, are provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1-6,

12-17 of copending Application No. 09/994450, and over claims 1-6, 12-17 of copending

Application No. 10/015177. Although the conflicting claims are not identical, they are

not patentably distinct form each other because both contain similar subject matter within the claims such as: Providing extensible functions using a distributed computer network.

Although the co-related applications do not specifically state within the limitations, "address book functions", it would have been obvious to a person of ordinary skill in the art at the time of the present to modify the co-related applications to show a method and system for providing extensible client address book functions using a distributed computer network, as well as a method and system for providing the extensible functions mentioned in the claims of the co-related applications.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harter et al. U.S. Patent 6,212,564, discloses a means for optimizing desktops so that users can view the same address book information regardless of the users device.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/
2/4/05

FRANTZ B. JEAN
PRIMARY EXAMINER